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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,282	08/31/2006	Tae-Sook Jeong	428.1075	9406

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EXAMINER
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DAVIS, DEBORAH A

ART UNIT	PAPER NUMBER
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1655

MAIL DATE	DELIVERY MODE
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08/05/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/591,282	JEONG ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	DEBORAH A. DAVIS	1655	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 2-5 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 is/are allowed.
- 6) ☒ Claim(s) 6 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date: _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election of Group I, claims 1 and 6-8, in the reply filed on April 28, 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). All other claims are withdrawn from consideration.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6-8 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a composition for the treatment of cardiovascular disease does not reasonably provide enablement for the prevention thereof. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. Applicant's have reasonable demonstrated/disclosed that the claimed composition is useful as a therapeutic agent for treating cardiovascular disease. However, the claims also encompass using the claimed composition for prevention of cardiovascular disease, which is clearly beyond the scope of the instantly disclosed/claimed invention. Please note that preventing cardiovascular disease

Art Unit: 1655

requires a higher standard for enablement than does treating the disease, especially since it is notoriously well accepted in the medical art that the vast number majority of afflictions/disorders suffered by mankind cannot be prevented with current therapies, including those involving cardiovascular disease. Applicant is invited to show support to obviate this rejection.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Harrison et al., (Phytochemistry, Vol. 26, No. 4, 1987, pp. 1211-1212).

The claims are drawn to a composition for the treatment of cardiovascular disease containing any one of compounds represented by the following formula 1 to formula 5 disclosed in the instant claim 6.

The reference of Harrison et al anticipates the claim the claims by disclosing an extract from the leaf of *Torreya nucifera* in which a diterpenoid compound which has been isolated. The diterpenoid compound is represented by the formula in Table 1; wherein the "R1" group is a methyl, as instantly claimed (see page 1211, Table 1, experimental section, e.g.). Please note, that the cited art of Harrison would be capable of performing the intended use (i.e. treating of cardiovascular disease) because there is not a structural difference between the reference composition and the instantly claimed invention.

Art Unit: 1655

Therefore, the cited reference is deemed to anticipate the invention defined by the cited claims.

Claims 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Flores et al., (Bol. Soc. Chil. Quim. Vol. 46, No. 1, March 2001).

The claim is drawn to a composition for the treatment of cardiovascular disease containing any one of the compounds represented by the following formula 1 to formula 5, disclosed in the instant claim 6, wherein (R can be a methyl, hydroxymethyl, aldehyde, methylester).

The reference of Flores et al. anticipates the instant claims by disclosing a methanolic composition formed from the bark of *Prumnopytis andina* that contains a ferruginol compound -represented by structure 2, in Figure 1; wherein the "R" position is a methyl group, as instantly claimed. Please note, that the cited art of Flores would be capable of performing the intended use (i.e. treating of cardiovascular disease) because there is not a structural difference between the reference composition and the instantly claimed invention.

Therefore, the cited reference is deemed to anticipate the invention defined by the cited claims.

#### ***Allowable Subject Matter***

Claim 1 is allowable. The prior art neither teaches nor suggest an abietane diterpenoid compound wherein R is dimethoxymethyl) - as defined by instant claim 1.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBORAH A. DAVIS whose telephone number is (571)272-0818. The examiner can normally be reached on 8-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Deborah A. Davis,  
Patent Examiner, AU 1655  
July 2008

/Christopher R. Tate/  
Primary Examiner, Art Unit 1655